

REMARKS

Claims 1-13 and 23-25 are currently pending in this application. By this amendment, claims 1, 10, 23 and 24 have been to more clearly define the invention over the cited prior art, as discussed below. Applicant respectfully submits that the above amendments do not add new matter to the application and are fully supported by the specification.

In view of the above amendments and the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Preliminary Matters

Applicant believes that no extensions of time are required at this time. If extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a). Applicant believes that no further fees for net addition of claims are required at this time. Any fees required for extensions of time and any fees for the net addition of claims are hereby authorized to be charged to our Deposit Account No. 23-1951.

Rejections Under 35 U.S.C. § 103

Claims 1-13 and 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,383,482 issued to Gorsek, et al. ("the Gorsek '482 patent") in view of Eisenberg (1998). Applicant respectfully traverses this rejection for at least the following reasons.

The Examiner has failed to establish a *prima facie* case of obviousness for two reasons. First, the cited references, whether taken singly or in combination, fail to disclose or suggest each and every element of the claimed invention. Secondly, the requisite suggestion or motivation to combine the teachings of the Gorsek '482 patent with the teachings of Eisenberg to arrive at the claimed compositions does not exist.

The Examiner must establish that the cited references of record disclose or suggest all the limitations of the claimed invention. The Examiner's primary reference, the Gorsek '482 patent, is deficient to support the present rejection. The Gorsek '482 patent fails to teach or suggest a composition comprising HMB at all, let alone "in an amount of up to about 75 mg" as now required by amended independent claims 1, 10 and 23.

The Eisenberg reference fails to remedy the deficiencies of the primary reference. Like the Gorsek '482 patent, the Eisenberg reference fails to disclose or suggest the range limitations of independent claims 1, 10 and 23. Specifically, for example, the Eisenberg reference fails to teach or suggest compositions comprising HMB "in an amount of up to about 75 mg." Thus, even if the proposed combination were made as suggested by the Examiner, it does not result in the claimed invention.

Moreover, the Examiner has failed to provide a showing of the requisite suggestion or motivation to combine the Gorsek '482 patent and the Eisenberg reference to produce the composition of independent claims 1, 10 and 23. There is nothing in the Gorsek '482 patent that would lead one skilled in the art to look to Eisenberg to make the modifications in the claimed invention; nor, is there anything in Eisenberg that teaches or suggests using HMB in an appetite suppression formulation.

The Examiner maintains that “it is well known in the art that HMB causes a decrease in fat tissue as well as an increase in muscle tissue in athletes.” Office Action at page 4. But, the Eisenberg reference states that “HMB’s role in muscle-building and fat burning was only in response to exercise.” The claimed invention incorporates HMB in an appetite suppression formulation without any regard whether or not the individual is an athlete or engaged in exercise.

Indeed, the Eisenberg reference actually teaches away from appetite suppressant and weight loss compositions, when it states “I used it in a capsule form and gained three pounds in the first five days. Then, I gained 12 more pounds over the next two weeks.” (emphasis added). Hence, there is nothing in this reference that suggests the desirability of combining HMB with the “weight loss composition” of Gorsek. This is confirmed by the further statement that “[A]thletes and celebrities are moving away from appetite suppressers and towards supplements such as HMB and pyruvate.” Therefore, since the Eisenberg reference teaches away from appetite suppressant compositions, it sets forth no motivation or suggestion that its teachings should be combined with the teachings of the Gorsek ‘482 patent to arrive at the appetite suppressant or weight loss compositions of the invention.

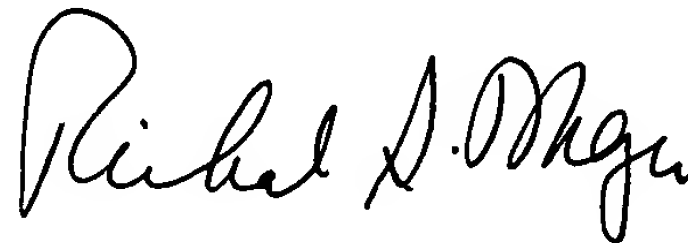
Accordingly, Applicant respectfully submits that the proposed combination of the Gorsek ‘482 patent and Eisenberg is an improper hindsight reconstruction of the invention and requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-13 and 23-25. Since none of the cited prior art references of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant respectfully submits that independent claims 1, 10 and 23, and all the claims that depend therefrom are allowable.

CONCLUSION

Applicant submits that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is thus respectfully requested to pass the above application to issue.

Should the Examiner feel that there are any issues outstanding after consideration of this response; the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested. Applicant respectfully requests that a timely Notice of Allowance be issued for this application.

Respectfully submitted,



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Date: November 12, 2004

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